



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/701,662	11/06/2003	Constance Marie Hendrickson	000529-00013	7385

27557 7590 09/10/2004

BLANK ROME LLP
600 NEW HAMPSHIRE AVENUE, N.W.
WASHINGTON, DC 20037

EXAMINER

LE, HOA VAN

ART UNIT	PAPER NUMBER
----------	--------------

1752

DATE MAILED: 09/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center">Office Action Summary</p>	<p>Application No.</p> <p>10/701,662</p>	<p>Applicant(s)</p> <p>HENDRICKSON ET AL.</p>	
	<p>Examiner</p> <p>Hoa V. Le</p>	<p>Art Unit</p> <p>1752</p>	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-28 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

This application is up for consideration.

A. A telephone call is made to the office of Mr. Charles R. Wolfe, Jr. on 02 September 2004.

Mr. Wolf, Jr. is not at his desk.

B. In view of the complexity of the inventions as set up this Office action is made.

C.1. Claims 1-15 are generic to a plurality of disclosed patentably distinct species comprising many possible copolymers as broadly disclosed in the art. Applicant is required under 35 U.S.C. 121 to elect a single disclosed chemical ingredient species of matrixes for an initiation of a search, even though this requirement is traversed.

2. Claims 1-28 are generic to a plurality of disclosed patentably distinct species comprising many possible co-solvents as broadly disclosed in the art. Applicant is required under 35 U.S.C. 121 to elect a single disclosed chemical ingredient species of antennas and their precursor and derivatives for an initiation of a search, even though this requirement is traversed.

3. Claims 1-28 are generic to a plurality of disclosed patentably distinct species comprising many possible non-solvent as broadly disclosed in the art. Applicant is required under 35 U.S.C. 121 to elect a single disclosed chemical ingredient species of color formers for an initiation of a search, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to

be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

- D. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 16-28, drawn to a solvent developer, classified in class 430, at least subclass 331.
 - II. Claims 1-15, drawn to a processing method, classified in class 430, at least subclass 306.

Inventions Group I and Group II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the process of washing out a soft portion of a layer on a support can be done with another solvent or the claimed solvent can be used to clean a grease soil on a tabletop. Applicant should show or provide a convincing evidence to the contrary. In the absence of convincing evidence, the restriction would not be removed.

Because these inventions are distinct for the reasons given above and have acquired the separate status and searches in the art and can be supported the separate patents as divided by applicants and have no evidence of the record that are not required

the separate consideration and search since they are the obvious variants because the prior art being applied to one of them would be sufficient against all inventions, restriction for examination purposes as indicated is proper. Applicant should show or provide an evidence to the contrary. In the absence of convincing evidence, the restriction would not be removed.

E An additional consideration or search for more than one invention, class or subclass in the art is burdensome, lacks of focus on many and all issues in the claimed inventions and dilutes patentability of many and all issues in many inventions than those in one. Applicant should show or provide a convincing evidence to the contrary. In the absence of convincing evidence, the restriction would not be removed.

F. Applicant is advised that the reply to this requirement to be complete must include an election as set forth on the record to be examined even though the requirement be traversed (37 CFR 1.143).

G. However any process claim is permitted to be rejoined with an elected material claimed Invention provided (a) that the material claimed invention is allowable and (b) the process claim must be contained all of the limitations of the allowable material claim in accordance with the authority stated in *In re Ochiai*, 37 USPQ2d 1127 or *In re Brouwer*, 37 USPQ2d 1663 and MPEP 821.04.

H. Other issues have not been considered until a proper election is made and resolved all of the requirements as clearly pointed out and set forth above.

I. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:30 AM to 4:00 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 703-872-9306,

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
02 September 2004

HOA VAN LE
PRIMARY EXAMINER

